UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,435	07/05/2001	Gero Offer	112740-257	3369

29177   7590   03/20/2008

BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER
CHEA, PHILIP J

ART UNIT	PAPER NUMBER
2153	

MAIL DATE	DELIVERY MODE
03/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte GEO OFFER

_____

Appeal 2007-3349
Application 09/899,435
Technology Center 2100

_____

Decided: March 20, 2008

_____

Before: JAMES D. THOMAS, LANCE LEONARD BARRY, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from a final
rejection of claims 1-25.

Claim 1 is exemplary:

1. A telecommunication network, comprising:

     a central server of an access or service provider, the central
server having an interrogation part for interrogating hardware and
software configurations of a plurality of terminal devices and a

software transmitting part for loading at least one of software and data
that is customized to the respectively detected hardware and software
configuration onto one of the plurality of terminal devices;

a plurality of terminal devices, each with a predetermined
hardware and software configuration, each of the plurality of terminal
devices including a response transmitting part for transmitting a
configuration code identifying the respective hardware and software
configuration to the central server in response to an inquiry by the
interrogation part,[1] each of the plurality of terminal devices also
including a software receiving part for receiving and internally storing
at least one of the transferred software and data, the interrogation part
and the response transmitting part being designed to interrogate the
respective hardware and software configuration and to transmit the
respective configuration code when at least one of the terminal device
logs onto the telecommunication network, predetermined times occur,
and predetermined time intervals occur;[2] and

distributed control parts, which are distributed in both the
central server and the plurality of terminal devices, the distributed
control parts implementing an interactive control over the software
transmitting part,[3] and being constructed for the interactive specifying

---

[1] In our analysis, we refer to "server having an interrogation part for
interrogating hardware and software configurations of a plurality of terminal
devices" and "response transmitting part for transmitting a configuration
code identifying the respective hardware and software configuration to the
central server in response to an inquiry by the interrogation part" as the
"transmitting requirement."

[2] In our analysis, we refer to "the interrogation part and the response
transmitting part being designed to interrogate the respective hardware and
software configuration and to transmit the respective configuration code
when at least one of the terminal device logs onto the telecommunication
network, predetermined times occur, and predetermined time intervals
occur" as the "three conditions."

[3] In our analysis, we refer to "distributed control parts, which are distributed
in both the central server and the plurality of terminal devices, the
distributed control parts implementing an interactive control over the
software transmitting part" as the "distributed control aspect."

of a charging mode for at least one of downloaded software and
downloaded data.

The references relied upon by the Examiner in rejecting the claims on
appeal are:

Shear	US 4,977,594	Dec. 11, 1990
Pepe	US 5,742,668	Apr. 21, 1998
Chen	US 5,797,016	Aug. 18, 1998
Nakagawa	US 5,835,911	Nov. 10, 1998
Valentine	US 6,018,654	Jan. 25, 2000
Shah	US 6,029,065	Feb. 22, 2000
Kobata[4]	US 6,058,418	May 2, 2000

"Adsenger.com Homepage." Adsenger, Aug. 15, 2000. (available at
http://web.archinve.org/web/20000815210943/http://www.adsenger.com/)

Claims 1-4, 14, 21, 22 and 24 stand rejected under 35 U.S.C. § 103(a)
as being unpatentable over Kobata and Nakagawa.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being
unpatentable over Kobata, Nakagawa, and Chen.

Claims 7, 12, 13, and 23 stand rejected under 35 U.S.C. § 103(a) as
being unpatentable over Kobata, Nakagawa, and Valentine.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being
unpatentable over Kobata, Nakagawa, and Pepe.

Claims 9-11 and 25 stand rejected under 35 U.S.C. § 103(a) as being
unpatentable over Kobata, Nakagawa, and Shear.

---

[4] With regard to Kobata, we base our analysis on U.S. Patent 6,058,418,
which is identified at Answer 4, instead of the patent number identified for
Kobata in the Evidence Relied Upon section at Answer 2.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobata, Shah, and Nakagawa.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobata, Shah, Nakagawa, and Chen.

Claim 18 stands rejected under 35 U.S.C. § 103(a) over Kobata, Shah, Nakagawa, and Pepe.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobata, Shah, Nakagawa, and Shear.

We affirm.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Kobata

1. Kobata teaches that a server sends a software package to one or more clients and that if the software package is installed on the client, the package causes the client to check and report to the server the hardware and software information, such as CPU power, hard disk space, applications, network connectivity, and log-in history. (Col. 1, l. 64 – Col. 2, l. 3 and Col. 4, ll. 57-64.)

2. Kobata teaches that the server distributes content to the client based on hardware and software information from the client. (Col. 5, ll. 22-27.)

Nakagawa

3. Nakagawa teaches a system that allows downloading software for a fee from a server to a client. (Abstract, ll. 10-18.)

4. Nakagawa teaches that control over software downloading can be initiated by the server and/or the client. (Abstract, ll. 3-22.)

5. Nakagawa teaches that payment for software involves interaction between a vendor (i.e., server) and a user (i.e., client). (Col. 68, ll. 17-29.)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). "[W]hen a

patent 'simply arranges old elements with each performing the same
function it had been known to perform' and yields no more than one would
expect from such an arrangement, the combination is obvious." *KSR*, 127 S.
Ct. at 1740 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)).

ANALYSIS

Claim 1

The Examiner concludes that the combined teachings and suggestions
of Nakagawa and Kobata[5] render claim 1 obvious. (Ans. 3-4.) Appellant
alleges that (1) the Examiner improperly combined the teachings and
suggestions of Nakagawa and Kobata; (2) the combination fails to teach the
transmitting requirement; (3) Kobata fails to teach the three conditions; and
(4) the combination fails to teach the distributed control aspect. (App. Br.
14-16 and Reply Br. 2-4.) Thus, the issues are whether Appellant has shown
that the Examiner erred as set forth by the Appellant in allegations (1) – (4).

Allegation (1): Combinability

The Examiner finds reason to incorporate Nakagawa's distributed
control aspect with Kobata's software download system because it allows
users to choose programs and methods of payment. (Ans. 4 and 14-15.)
Appellant alleges that there is no "teaching suggestion or motivation for one
having ordinary skill in the art to combine Kobata with Nakagawa." (App.
Br. 14-15 and Reply Br. 2-4.) In particular, Appellant alleges that
implementing Nakagawa's charging mode for Kobata's downloaded
advertisements renders Kobata's system unsatisfactory for its intended

---

[5] Hereafter, we refer to the combined teachings and suggestions of Nakagawa
and Kobata as the "combination."

purpose because it requires that receivers of advertisements *pay for the advertisements*. (*Id.*)

We find that Kobata teaches transmitting content (FF 2) and does not require transmitting advertisements. Accordingly, we disagree that Kobata's intended purpose is distributing advertisements and thus disagree that modification of Kobata's system to include charging for downloaded content renders Kobata's system unsatisfactory for its intended purpose.

In addition, we conclude there was sufficient reason to combine Kobata's software distribution system with Nakagawa's distributed control aspect[6] because "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR,* 127 S. Ct. at 1740 (citing *Sakraida,* 425 U. S. at 282). At the time of the invention, combining (a) Kobata's software distribution system with (b) Nakagawa's distributed control aspect changed the functions of none of the combined features of (a) and (b). Moreover, the combination yielded no more than predictable results of permitting distributed control among a server and terminals over downloads and a charging mode. *Id.*

Thus, we conclude that Appellant has not shown that the Examiner erred in combining Kobata's software distribution system with Nakagawa's distributed control aspect.

---

[6] We conclude that the combination teaches a distributed control aspect for reasons provided with regard to allegation (4), *infra.*

Allegation (2): Transmitting Requirement

Appellant alleges that neither Kobata nor Nakagawa teaches the transmitting requirement. (App. Br. 15 and Reply Br. 4-5.) Appellant also alleges that neither Kobata nor Nakagawa teaches the configuration code that identifies hardware and software configuration of the terminal device. (*Id.*)

We find that Kobata teaches that a server transmits a software package to a client and that the software package causes the client to check and report to the server the client's hardware and software information, such as CPU power, hard disk space, applications, network connectivity, and log-in history. (FF 1.) We find that the hardware and software information meet the claimed configuration code. Moreover, we find that the client reporting the hardware and software information *in response* to the server transmitting a software package to the client discloses interrogation. Accordingly, we find that Kobata's client transmitting the hardware and software information in response to the server transmitting a software package to the client teaches the transmitting requirement.

Thus, we conclude that Appellant has not shown that the Examiner erred in finding that the combination teaches the transmitting requirement.

Allegation (3): Conditions to Interrogating and Transmitting

Appellant alleges that Kobata does not teach the three conditions by merely stating that "Kobata clearly fails to teach this configuration." (App. Br. 16 and Reply Br. 5.)

The Examiner has identified a portion of Kobata to support a finding that Kobata teaches the three conditions. (Ans. 3-4.) Appellant merely quotes the claim language and states that Kobata does not teach the quoted claim language. Such statement does not persuade us of Examiner error.

Thus, we conclude that Appellant has not shown that the Examiner erred in finding that the combination teaches the three conditions.

Allegation (4): Distributed Control Aspect

The Examiner finds that Nakagawa teaches the distributed control aspect because it teaches *interaction* between a server and client to control software transmission and a charging mode for software downloads. (Ans. 4 and 16.) Appellant alleges that neither Kobata nor Nakagawa teaches the distributed control aspect because Nakagawa teaches *server side* control only. (App. Br. 16 and Reply Br. 5.) In addition, Appellant alleges that Kobata teaches away from distributed control because it teaches server side control. (*Id.*)

Appellant's Specification describes distributed control as involving interaction between a terminal and a server to determine whether to transmit software to the terminal. (Spec. 3:26 - 4:7.) In particular, Appellant's Specification states that a terminal's configuration code and selection/rejection of software determine whether a server downloads

software to the terminal. (*Id.*) Accordingly, we broadly but reasonably construe the distributed control aspect to involve interaction between a server and clients for software transmission and a charging mode.

We find that Kobata teaches that a client interacts with a server to coordinate downloading of software from the server to clients. (FF 1-2.) In addition, we find that Nakagawa teaches interaction between the server and clients during downloading software and payment for software. (FF 3-5.) Accordingly, we find that the combination teaches the distributed control aspect by teaching interaction between a server and clients for software transmission and a charging mode.

Moreover, Appellant's argument concerning teaching away is unavailing because we found that the combination teaches interactive control by server and client as opposed to server side control only.

Thus, we conclude that Appellant has not shown that the Examiner erred in finding that the combination teaches the distributed control aspect.

Therefore, because Appellant has not shown that the Examiner erred according to allegations (1) – (4), we conclude that Appellant has not shown that the Examiner erred in concluding that the combination renders claim 1 obvious.

<div align="center">Claim 15</div>

The Examiner concludes that the combined teachings and suggestions of Kobata, Shah, and Nakagawa render claim 15 obvious. (Ans. 10-11.) Appellant alleges that the combination of the teachings of Kobata with those of Shah and Nakagawa is improper. (App. Br. 17 and Reply Br. 6.) Appellant also argues that the references fail to teach all elements of claim

<div align="center">10</div>

15 by referring to arguments that the combination fails to teach all elements
of claim 1. (App. Br. 18 and Reply Br. 7.)

We addressed Appellant's allegations with regard to claim 1 *supra*
and thus the sole issue for this group is whether Appellant has shown that
the Examiner erred in combining teachings of Shah with the proper
combination of the teachings of Kobata and Nakagawa.

The Examiner finds that incorporating Shah's interactive menu into
Kobata's system would be desirable because it allows users to select content.
(Ans. 11 and 16-17.) Appellant alleges that there is "no teaching suggestion
or motivation" to combine the references in the manner suggested in the
Office Action. (App. Br. 17 and Reply Br. 6.) In particular, Appellant
alleges that the Office Action does not (1) reconcile why Shah's interactive
menu on a *wireless network* would be incorporated into Kobata's line-based
system and (2) explain why Shah's interactive menu would be needed in
Kobata's push system. (*Id.*)

We conclude there was sufficient reason to combine Kobata and
Nakagawa's software distribution system with Shah's interactive menu
because "when a patent 'simply arranges old elements with each performing
the same function it had been known to perform' and yields no more than
one would expect from such an arrangement, the combination is obvious."
KSR, 127 S. Ct. at 1740 (citing *Sakraida,* 425 U. S. at 282). At the time of
the invention, combining (a) Kobata and Nakagawa's software distribution
system with (b) Shah's interactive menu changed the functions of none of
the combined features of (a) and (b). Moreover, the combination yielded no
more than predictable results of permitting a user to select downloaded

content. *Id.* Thus, we conclude that Appellant has not shown that the Examiner erred in combining teachings of Shah with those of the combination.

Therefore, we conclude that Appellant has not shown that the Examiner erred in concluding that the combined teachings of Shah with the combination render claim 15 obvious.

Other Claims

Each claim in the following claim groups is subject to the same rejection as claim 1 or to a rejection based on the same prior art as the rejection of claim 1 in combination with additional prior art: (i) Claims 2-4 and 14; (ii) Claims 5 and 6; (iii) Claims 7, 12, and 13; (iv) Claim 8; and (v) Claims 9-11. With regard to these claims, Appellant relies on the same arguments as those set forth for claim 1. (App. Br. 17 and Reply Br. 6.) Therefore, as to the rejection of these claims, Appellant has not shown Examiner error for the same reasons discussed *supra* with respect to claim 1.

Each claim in the following claim groups is subject to the same rejection as claim 15 or to a rejection based on the same prior art as the rejection of claim 15 in combination with additional prior art: (i) Claim 16; (ii) Claim 17, (iii) Claim 18; and (iv) Claims 19 and 20. With regard to these claims, Appellant relies on the same arguments as those set forth for claim 15 to allege Examiner error. (App. Br. 18 and Reply Br. 7.) Therefore, as to the rejection of these claims, Appellant has not shown Examiner error for the same reasons discussed *supra* with respect to claim 15.

Each claim in the following claim groups is subject to the same rejection as claim 1 or to a rejection based on the same prior art as the rejection of claim 1 in combination with additional prior art: (i) Claims 21, 22 and 24; (ii) Claim 23; and (iii) Claim 25. With regard to these claims, Appellant relies on the same arguments as those set forth for claim 15. (App. Br. 18 and Reply Br. 7.) To allege Examiner error with regard to claim 15, Appellant relies on (i) arguments made with regard to claim 1 that are applicable to these claims as well as (ii) arguments that are applicable to claim 15, but not applicable to these claims. (*Id.*) We addressed arguments concerning claim 1 that are applicable to these claims *supra* with regard to claim 1. Therefore, as to the rejection of these claims, Appellant has not shown Examiner error for the same reasons discussed *supra* with respect to claim 1.

<div align="center">CONCLUSION OF LAW</div>

We conclude that:

(1) Appellant has not shown that the Examiner erred in concluding that:

> Claims 1-4, 14, 21, 22 and 24 are unpatentable under 35 U.S.C. § 103(a) over Kobata and Nakagawa;

> Claims 5 and 6 are unpatentable under 35 U.S.C. § 103(a) over Kobata, Nakagawa, and Chen;

> Claims 7, 12, 13, and 23 are unpatentable under 35 U.S.C. § 103(a) over Kobata, Nakagawa, and Valentine;

> Claim 8 is unpatentable under 35 U.S.C. § 103(a) over Kobata, Nakagawa, and Pepe;

<div align="center">13</div>

Claims 9-11 and 25 are unpatentable under 35 U.S.C.

§ 103(a) over Kobata, Nakagawa, and Shear;

Claims 15 and 17 are unpatentable under 35 U.S.C.

§ 103(a) over Kobata, Shah, and Nakagawa;

Claim 16 is unpatentable under 35 U.S.C. § 103(a) over
Kobata, Shah, Nakagawa, and Chen;

Claim 18 is unpatentable under 35 U.S.C. § 103(a) over
Kobata, Shah, Nakagawa, and Pepe;

Claims 19 and 20 are unpatentable under 35 U.S.C.

§ 103(a) over Kobata, Shah, Nakagawa, and Shear; and

(2) Claims 1-25 are unpatentable.

DECISION

The Examiner's rejections of claims 1-25 are affirmed.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

pgc

BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO IL 60690